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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,546	12/22/2000	Steven J. Hensen	LC-355PCT US	9980

7590

08/15/2003

Loctite Corporation
Legal Department
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EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/719,546

Applicant(s)

HEMSEN, STEVEN J.

Examiner

Katherine A. Bareford

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): see attached pages.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-24 and 27-35

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Advisory Action

1. As to Box 3 of the Advisory Action Form PTO-303:

The proposed amendment of July 31, 2003 has overcome the following objections/rejections only:

- (1) the objection to claims 25 and 26 are overcome due to the canceling of those claims.
- (2) the objection to claim 9 is overcome due to the proposed amendment to the claim 9.

2. As to Box 5 of the Advisory Action Form PTO-313:

The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

Applicant's Arguments

Applicant has argued that the cited Kerns reference is concerned with encapsulation and is not concerned with the different process ^{of} impregnation of the pores of a porous article.

Furthermore, there is no motive to combine the teachings of Kerns with the alleged admitted state of the prior art because the admitted state of the prior art is concerned with the filling of pores within porous articles, while Kerns is concerned with forming a protective/cosmetic shell around an object. Applicant further argues that Kerns uses a "castable" resin system, which would add significant complexity to the process. As to the use of the Schon reference, applicant argues that this reference is concerned with filling the pores of a solid object such as carbon or graphite electrodes with a filler material, described as "pitch" or "tar", and is not concerned with the use of a polymerizable composition. The process of Schon requires a heating stage prior to

impregnation in order to heat the porous material and the pitch to facilitate the impregnation of the pitch into the pores of a porous article, but, the use of such a heating step in the process of applicant would partially or completely polymerize the impregnating composition, making it incapable of impregnating the pores, and thus rendering the composition useless for its intended purpose. Furthermore, according to applicant, Schon's treatment provides an electrode which is said to have increased current carrying capacity, improved shock resistance, and increased capacity. In contrast, applicant's impregnation process fills the pores of a porous article with a polymerizable composition for the purpose of sealing against leaks. These disparate objectives would fail to lead one of ordinary skill in the art to applicant's invention from a reading of Schon.

The Examiner's Response

The Examiner has reviewed the above arguments, however, the rejection is maintained. The rejection of the pending claims is based on a combination of three references, each of which must be considered in their whole entirety. The primary reference is to the admitted state of the prior art which, as discussed in the Final Rejection, teaches the various steps of impregnating the pores of an article with a polymerizable composition, and further teaches that this process is known to take place in a single, immobile chamber (i.e. a batch process) which provides the disadvantage of a lengthy duration of treating time and a requirement of sequential step processing as well as other problems. Kerns, which applicant appears to be arguing is non-analogous art, is cited as a secondary reference. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis

for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). While Kerns is directed to encapsulating, it also indicates the benefits of switching from a batch process to a transporting process, which allows improved treating times, i.e. that switching from a batch to a transporting process provides improvements of the problem with batch processing discussed by the primary reference. As a result, it is, at the least, reasonably pertinent to the problem of switching from a batch process to a transport process. As to the resins disclosed by Kerns, Kerns teaches a variety of resins, including thermoset or thermoplastic and clearly indicates that resin materials can be used in a transport process that includes vacuum pressurization. As to Schon, it is also, at the least, reasonably pertinent to the problem of switching from a batch impregnation process to a transport process, by indicating the known use of transport impregnation process features. While Kerns and Schon do not teach various features claimed by applicant, these references are the secondary references, and are used to teach various desirable features of a transport process as discussed in the Final Rejection.

3. As to Box 7 of the Advisory Action Form PTO-303:


For purposes of Appeal, the proposed amendments will be entered. The rejected claims will be claims 1-24 and 27-35, which will be rejected for the reasons given as to these claims in the Final Rejection and for the reasons discussed in paragraph 2 above. Claims 25-26 will be canceled.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KATHERINE A. BAREFORD
PRIMARY EXAMINER
GROUP 4400/700